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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,092	03/19/2001	Raymond W. Sanders	77410/501	1211

7590 09/12/2005

Frost Brown Todd LLC  
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Cincinnati, OH 45202

EXAMINER

FRIDIE JR, WILLMON

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/812,092	SANDERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Willmon Fridie	3722	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6-9,11,13-18,20,22,24-40,42,44-50 and 52-63 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-63 is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8,11,13-18,22,24-33,42,45-48,52 and 53 is/are rejected.
- 7) ☒ Claim(s) 9,20,34-40,44,49 and 50 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### ***Claim Rejections - 35 USC § 112***

Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

From what does claim 52 depend ?

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11, 13-18, 28-33, 45-48 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Forrest.

Forrest ('978) discloses a certified mailer for attachment to an object to be mailed by a sender to a recipient, said mailer comprising: a single sheet (10) having a first and second surface, said sheet comprising an integral one piece structure, said sheet comprising: a first portion (11) comprising a return receipt card (36) comprising an integral part of said sheet, defined in said single sheet by a frangible boarder (48,49), said return receipt card being detachable from said sheet along said frangible boarder, a second portion (12) comprising a

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recipient address label (52) (see column 6, lines –17) for recipient indicia, wherein said first portion comprises a first panel and said second portion comprises a second panel, said sheet includes first and second panels connected to each other at a first interface, wherein said second panel is connected to said first panel along at least a portion of said frangible boarder (16) of said first detachable form and wherein said first interface is defined by a foldline wherein said second surface of said return receipt card includes indicia (42) thereon defining an area for entering recipient indicia, wherein said return receipt card comprises first and second surfaces , said first surface including sender indicia thereon and wherein said second surface of said return receipt card includes recipient indicia thereon.

Claims 1-4,6-8,11,13-18,24,25,27,28-33, 45-48 and 52, 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Petkovesek ('277).

Petkovesek ('277) discloses a certified mailer for attachment to an object to be mailed by a sender to a recipient, said mailer comprising: a single sheet having a first and second surface, said sheet comprising an integral one piece structure, said sheet comprising: a first portion comprising a return receipt card (14) comprising an integral part of said sheet, defined in said single sheet by a frangible boarder (48,48'), said return receipt card being detachable from said sheet along said frangible boarder, a second portion comprising a recipient address label (16,16') for recipient indicia. wherein said first portion comprises a first panel and said second portion comprises a second panel. said sheet includes first and second panels connected to each other at a first interface. wherein said second panel is connected to said first panel along at least a portion of said frangible boarder (12) of said first detachable form and wherein said first interface is defined by a foldline wherein said second surface of said return receipt card includes indicia

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thereon defining an area for entering recipient indicia (32,32') wherein said return receipt card comprises first and second surfaces, said first surface including sender indicia thereon (30,30').

Petkovesek ('277) further comprises adhesive disposed on at least a portion of said second surface of said sheet whereby said sheet may be secured to said object without securing said detachable form to said object, wherein said adhesive must be actuated in order to secure said sheet to said object and wherein said adhesive is covered by at least one protective strip (46,46'), said adhesive being actuatable by removing said at least one protective strip.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 22, 26 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovesek ('277).

With respect to claims 22 and 42 it would have been obvious to one having ordinary skill in the art at the time the invention was made to use tracking indicia since it would only depend

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on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

With respect to claim 26, Official Notice is taken in regard to the use of moisture activated adhesives.

#### ***Allowable Subject Matter***

Claims 54-63 are allowed.

Claims 9,20,34-40,44,49 and 50 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Fridle whose telephone number is 571 272 4476. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571 272 4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WILLMON FRIDIE, JR.  
PRIMARY EXAMINER